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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/083,245	02/25/2002	James W. Darrow	U 013888-7	8430

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LAWSON & WELTZEN, LLP
88 BLACK FALCON AVE
SUITE 345
BOSTON, MA 02210

EXAMINER	
TRUONG, TAMTHOM NGO	

ART UNIT	PAPER NUMBER
1624	

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/083,245	DARROW ET AL.	
	Examiner	Art Unit	
	Tamthom N. Truong	1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *2-14-05 (ELECTION)*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-52* is/are pending in the application.

4a) Of the above claim(s) *3-6,13-17,42-44,47-50 and 52* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,7-12,18-41,45,46 and 51* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *2-25-02; 3-29-02;* 7/7/04
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Applicant's election of Group 11 in the reply filed on 2-14-05 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

It is noted that claims 3-6 have X as N, and so, they do not belong to Group 11. Thus, the elected claims are 2, 7-12, 18-41, 45, 46 and 51.

Claims 3-6, 13-17, 42-44, 47-50 and 52 are withdrawn from consideration for being drawn to the non-elected subject matter.

The preliminary amendment indicated claim 1 as being deleted (not cancelled). However, claim 2 has not been amended to include limitations of claim 1. Therefore, the following rejections are based on claim 1 as if it is still pending.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A **statutory type** (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

1. Claims 1, 2, 7-12, 18-22 and 37-41 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 2, 7-12, 16-20 and 35-39 of prior U.S. Patent No. **6,372,743** B1. This is a double patenting rejection.

The instant claims 1, 2 and 7-12 recite the same compounds as those recited in claims 1. 2 and 7-12 of US'743. The instant claims 18-20 recite compounds with a K_i value the same as that of the compounds recited in claims 16-18 of US'743. The instant claims 21 and 22 recite the same methods as those recited in claims 19 and 20 of US'743. The instant claims 37-41 recite the same species as those recited in claims 35-39 of US'743.

The **nonstatutory double patenting** rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 23-27, 28-36, 45, 46 and 51 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 21-34, 43, 44 and 49 of U.S. Patent No. **6,372,743** B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the instantly claimed formula I falls

within the scope of formula I in US'743. Thus, it would have been within the level of the skilled chemist to recognize that the instantly claimed formula I is a subgenus of the formula I in US'743. Therefore, it would have been obvious for the skilled chemist to select compounds of the instant formula I and incorporate them in a pharmaceutical composition for use in the treatment of obesity as well as other diseases.

3. Claims 1, 2, 7-12, 18-41, 45, 46 and 51 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 and 25-31 of U.S. Patent No. **6,476,038** B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of formula I of US'038 falls within the scope of the instantly claimed formula I. Thus, it would have been within the level of the skilled chemist to recognize that the instantly claimed formula I is a genus of the formula I in US'038. Therefore, it would have been obvious for the skilled chemist to select compounds of the instant formula I and incorporate them in a pharmaceutical composition for use in the treatment of obesity as well as other diseases.

No pending claims are allowed.

References cited on PTO-892

References cited on PTO-892 only show state of the art. The closest reference, **Gilligan et. al.** (US 6,060,478), provides analogous compounds. However, its generic teaching is too

broad for a prima facie case of obviousness according to **In re Baird**, 16 F.3d 380, 382, 29 USPQ 2d 1550, 1552 (Fed. Cir. 1994).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamthom N. Truong whose telephone number is 571-272-0676. The examiner can normally be reached on M-F (10:00-6:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tamthom N. Truong
Examiner
Art Unit 1624

RICHARD L. RAYMOND
PRIMARY EXAMINER
ART UNIT 1624

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4-6-05